

Remarks/Arguments

1. Background

On November 17, 2004 a Final Office Action concerning the above identified Application was mailed to Applicants. On January 18, 2005 an After Final Amendment & Response including a Rule 1.131 Declaration signed by the Applicants and a Declaration by Applicant's Representative in Accordance with MPEP 608.01(p) was filed with the US Patent & Trademark Office. On March 1, 2005 an Advisory Action was mailed to Applicant's Representative by the US Patent & Trademark Office.

The March 1, 2005 Advisory Action indicated that the After Final Amendment & Response failed to place the present Application in condition for allowance, although the §112 1st and 2nd paragraph rejections had been overcome. The Advisory Action further stated that for purposes of Appeal the proposed amendments would be entered. The Advisory Action additionally stated that the Declaration under 37 CFR 1.131 by Applicants is not persuasive as it was not clear in which way (see MPEP 715.07) the Declaration is intended to establish prior invention and that the scope of the Declaration was not commensurate with the scope of the claims.

In view of the Advisory Action, Applicant is not clear as to whether the proposed Amendments to the claims have been entered. Thus and for the Examiner's convenience the

claims (including claim status) as provided in the After Final Amendment & Response of January 18, 2005 have been included herewith in the above listing of claims. If these amendments have not been entered, Applicant hereby respectfully requests that the Amendments to the specification and claims as proposed in the After Final Amendment and Response of January 18, 2005 be entered. As noted in the After Final Amendment & Response of January 18, 2005 no new matter has been added by any of the proposed Amendments.

2. Arguments/Response with RCE

Claims 1-20 are pending and stand rejected only under section 103(a), given entry of the January 18, 2005 proposed amendments which as noted in the Advisory Action of March 1, 2005 overcome the §112 1st and 2nd paragraph rejections recited by the November 17, 2004 Final Office Action.

An amendment to the specification that adds a Related Applications paragraph has been proposed. A Rule 1.131 Declaration by Applicants is enclosed showing prior invention. No claims have been amended other than those amended in the After Final Amendment & Response of January 18, 2005.

In view of the comments below, Applicant respectfully requests that the Examiner enter all proposed amendments to the specification and claims, reconsider the present application

including claims 1-20, withdraw the rejection of these claims, and move this application to allowance.

a) Claims 1-6 and 8-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang et al. (U.S. Patent No. 6,560,755 B1).

Zhang et al qualifies as a reference, if at all, only under 35 U.S.C. 102(e), i.e. “a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent ...” In view of the enclosed April 1, 2005 Rule 1.131 Declaration duly signed by the Applicants, the present invention was conceived before August 24, 2000 and due diligence was exercised from a date prior to August 24, 2000, the effective date of Zhang et al., to September 1, 2000, the filing date of the present Application.

More particularly, the April 1, 2005 Rule 1.131 Declaration states “In accordance with MPEP 715.07 (C) this Declaration and any attachments is intended as a statement of facts sufficient to show conception of the invention prior to August 24, 2000, the effective date of the ‘775 Patent, coupled with due diligence from prior to the effective date of the ‘775 Patent to September 1, 2000, the filing date of the Subject Application (constructive reduction to practice).” Thus it is believed that any clarification needed as requested in the Advisory Action of March 1, 2005 has been provided. Furthermore, as indicated in Appendix III beginning at page 23, the claimed invention clearly included a mismatch modeling tool and clearly included ASCII output data files among various other aspects.

Thus and in view of the statement of facts and other evidence provided in the April 1, 2005 Rule 1.131 Declaration, Applicant respectfully submits that Zhang et al is not a proper reference to support a rejection of claims 1-6 and 8-20 under 35 U.S.C. 103(a) since Zhang et al was filed after the invention by the Applicants. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection of claims 1-6 and 8-20 under 35 U.S.C. 103(a) based on Zhang et al. (U.S. Patent No. 6,560,755 B1).

b) Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Zhang et al. (U.S. Patent No. 6,560,755 B1) in view of Hussey (U.S. Patent No. 5,826,269).

See the discussion above at a). Given the effective date and the April 1, 2005 Rule 1.131 Declaration as above noted, Zhang et al. is not a proper reference to support this §103(a) rejection of claim 7. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

c) Accordingly, Applicant respectfully submits that the application, as amended, resolves all issues under §112 and that claims 1-20 clearly and patentably distinguish over all appropriately cited references of record and as such are to be deemed allowable. Such allowance is hereby earnestly and respectfully solicited at an early date. If the Examiner has any suggestions or comments or questions, calls are welcomed at the phone number below.

Although it is not anticipated that any fees are due or payable other than the separately noted RCE fee and Petition for 1 month extension (the present response is being timely filed within 1 month of the date of the Advisory Action), the Commissioner is hereby authorized to charge any fees that may be required to Deposit Account No. **50-3435**.

Respectfully submitted,

Charles W. Bethards
Charles W. Bethards
Reg. No. 36,453

Enclosures:

Rule 1.131 Declaration, Appendix I, II, III
Power of Attorney,

Law Office of Charles W. Bethards, LLP
P.O. Box 1622
Colleyville, Texas 76034
Phone (817) 581-7005
Fax (817) 281-7136
Customer No. 51894